REMARKS

Claims 1-19 are pending, but stand rejected. That rejection has been made final. Claim 19 has been amended to more clearly indicate that the recited computer readable code is provided on a computer readable medium. The amendment does not require a further search and the applicants respectfully ask the Examiner to enter the amendment.

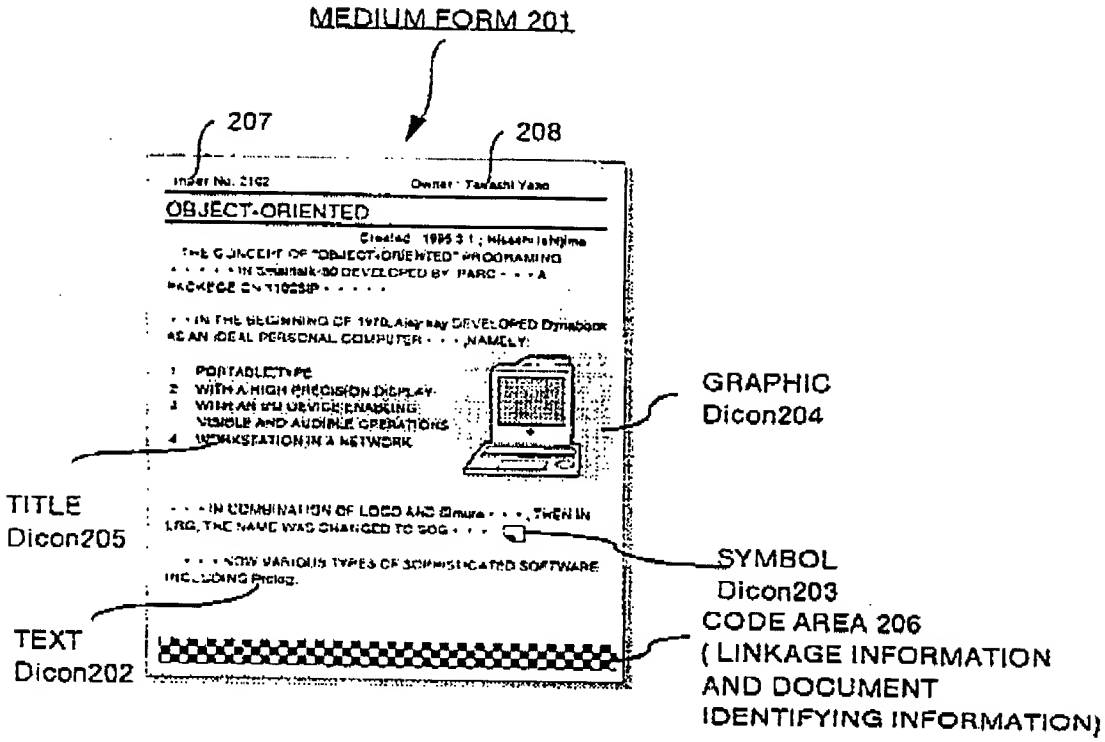
In view of the following remarks, the Applicant respectfully asks that the Examiner reconsider and withdraw the rejections.

Double Patenting: It is again submitted that the Applicant is willing to consider the filing of a terminal disclaimer, however still wishes to wait until either this application or one of co-pending applications listed in the previous response, issues. This will establish which applications will be terminally disclosed with respect to which. In the interim, the double patenting rejection is provisionally traversed for at least the reason that it is not yet determined what the exact scope of the claims of each application will be at the time of their respective allowance. The double patenting rejection is also traversed in that the claims of this and the other two applications have been amended in a manner which is deemed to overcome the rejection.

Claim Rejections – 35 USC §103: Claims 1-10, 13, 14, 18, and 19 have been rejected as being unpatentable over USPN 6,537,324 issued to Tabata in view of USPN 6,375,078 issued to Russell.

Tabata discloses a system for utilizing printed physical documents as if they were web pages displayed on a computer screen. Tabata labels this concept PUI or Paper User interaction. *See, e.g.,* Tabata, col. 7, line 56 through col. 8, line 14. Such a printed document is referred to as medium form (201) where medium form information is the printed information on the medium form (201). *See* Tabata, col. 8, lines 31-58 (describing medium form information), and Tabata, col. 5, lines 47-57 (describing medium form information), and Fig. 2, reproduced below.

FIG.2



A printed medium form (201) is produced from a hypertext document. Tabata, col. 6, lines 26-37. The medium form (201) includes dicons (204) – (205) and a code area (206). Tabata, col. 8, lines 31-58. Dicons (204) – (205), also referred to as "described information" are text or images printed on medium form (201) that serve as the functional equivalent of a hyperlink included in a web page. *See, e.g.*, Tabata, col. 8, line 59 through col. 9, line 57. A dicon can take the form of text, an icon, or a graphic. Tabata, col. 9, lines 18-31. The linkage information encoded in code area (206) links or otherwise associates each dicon with a "correlated information file." *See* Tabata, col. 10, line 8-53 and Fig. 7.

A user, with printed medium form (201) in hand, checks or otherwise marks a selected dicon with a pen or other writing instrument. *See*, Tabata, Fig. 5. The medium form (201) is then scanned to create a raster image that is compared to a raster image of the original hypertext from which the medium form (201) was produced. *See* Tabata, col. 6, line 65 through col. 7, line 4; step 1202 of Fig. 12. The difference between the raster images reveals the mark. *See* Tabata, col. 6, line 65 through col. 7, line 4; step 1202 of Fig. 12. The portion of the raster image containing the code section (206) can then be decoded to obtain linkage information for a dicon corresponding to the revealed mark. *See* Tabata, col. 6, line 65 through col. 7, line 4; step 1202 of Fig. 12. Using that linkage information, a correlated information file linked to that dicon can be retrieved and printed. *See* Tabata, steps 1207-1211 of Fig. 12. Where that correlated information file is a hypertext document, a file server (440) converts that hypertext document to medium form information to be sent to a printer to print another medium form (201). *See* Tabata, col. 15, lines 33-44; step 1210 of Fig. 12; col. 29, lines 1-6; and step 2105 of Fig. 21.

Claim 1 is directed to a printing method and recites the following acts:

1. receiving print stream data at a printer;
2. detecting, at the printer, a network address in the received print stream data;
3. if a network address is detected, then displaying or sending a message from the printer notifying a user entity of the network address detection and requesting authorization from the user entity to access the network address;
4. if authorization to access is received from the user entity at the printer, sending on the Internet or other network, an access request for a document to the network address from the Printer;
5. retrieving the document from the network address at the printer;

6. merging, at the printer, the document from the network address into the print stream data to form a modified document; and
7. printing the modified document.

Neither Tabata nor Russell, individually or combined, teaches merging, at a printer, a document into print stream data (received at the printer) to form a modified document where the document being merged into the print stream data was obtained at the printer from a network address detected in the print data stream in the manner recited by Claim 1. The Examiner asserts that Tabata teaches all but the third and fourth acts listed above. Specifically, the Examiner states: "Tabata differs from claims 1, 6, and 19 in that he does not clearly disclose requesting from the printer (copier 470) authorization from a user entity to access the network address." For only these portions of Claim 1, did the Examiner rely on Russell.

The Examiner mistakenly asserts that Tabata teaches merging, at the printer, the document from the network address into the print stream data to form a modified document, citing Tabata col. 30, line 46 through col. 31, line 19 and col. 24, lines 24-49. The cited passages from Tabata are reproduced as follows:

> The document information management system according to the present invention comprises a file unit with information relating to particular words, sentences, symbols, or graphics previously stored therein as a correlated information file; a medium form with at least one described information comprising any of words, sentences, symbols, and graphics, linkage information for linking the described information to the correlated information file in the file unit, and selection information for selecting particular described information among the described information recorded thereon; a correlated information identifying unit for reading image data from the medium form, identifying the selected correlated information file according to the selection information as well as linkage information in the read image data, and outputting an address of an appropriate correlated information file; a correlated information file retrieving unit for receiving an address of the correlated information file from the correlated information identifying unit and retrieving an appropriate correlated information file from the file unit according to the address of the correlated information file; an image data reader for reading image data from the medium form; a correlated information file

identifying/retrieving unit for receiving image data from the image data reader, identifying an address of the selected correlated information file according to the selection information and linkage information in the image data, and retrieving the appropriate correlated information file from the file unit; and an output unit for outputting the correlated information file retrieved by the correlated information file retrieving unit or the correlated information file identifying/retrieving unit, so that continuity and correlation of information between a digital world such as a computer system and a paper document can be constructed, a paper document can be incorporated in the document information management system in the digital world, direct access to the digital world can be achieved by using the paper document as a medium, and further a hypertext using the paper document (paper hypertext) can be realized.

Tabata, col. 30, line 46 through col. 31, line 19.

The file server transfers the retrieved correlated information file to a printer 460 or to a printer 470B (S2104). However, **when the correlated information file itself is found also a hypertext, as it is required to output the correlated information file as medium form information, the file server 440 prepares medium form information from the hypertext and transfers the medium form information to the printer 460 or 470B (S2105).** Specification of the printer 460 or 470B as an address for transferring at that time can easily be realized by describing it on the medium form 420 or by selecting it on the medium form 420 although detailed description is omitted herein.

The printer 460 or 470B outputs the received correlated information file (including the medium form information) on recording paper as a correlated information file 450 (S2106).

As described above, with the document information management system according to Embodiment 4, continuity and correlation of information from a hypertext as a document in the digital world such as a computer system to a medium form 420 as a paper document are constructed through the linkage information on the medium form 420, so that a paper document can be incorporated in the document information management system in the digital world, direct access to the digital world can be achieved by using the paper document as a medium, and further a hypertext using the paper document (paper hypertext) can be realized.

Tabata, col. 24, lines 24-49 (emphasis added).

Following the citation of these two passages, the Examiner mischaracterizes Claim 1 by adding the following parenthetical: "(the correlated information file is incorporated with the medium form information to form a single document)". As clarified below, this is simply irrelevant to the limitations of Claim 1.

Tabata discloses assembling medium form information which is then used to print a medium form. Medium form information is assembled from a hypertext document. That hypertext document may have been retrieved following a scan of a medium form having a marked dicon linked via an URL or other address to that hypertext document. That address is not detected at a printer and is not detected within print stream data in the manner required by Claim 1.

Medium form information includes, information regarding the visual appearance of the hypertext document (image extraction information), dicons (described information), and linkage information. *See, e.g.*, Tabata, col. 5, lines 28-36 (discussing preparing medium form information from a hypertext document). Medium form information is prepared at a printer server 30 or file server 440 which in turn transfers the medium form information to a printer. Tabata, col. 5, lines 28-36 (printer server 30) and col. 29, lines 1-6 (file server 440). Tabata mentions:

> Although a printer server is used herein as a medium form information preparing unit, it is not particularly restricted thereto, and it is needless to say that any device such as a personal computer/work station enabling execution of the medium form information preparing software may be employed. Also, a function as a medium form information preparing unit may be given to the file server 20 in place of discretely providing the printer server 30 as a medium form information preparing unit.

Tabata, col. 6, lines 38-46. Tabata makes no mention or suggestion medium form information could be assembled at a printer.

Even if Tabata's medium form information is considered to be print stream data, it only becomes so after being sent to a printer – that is – only after it is sent from a printer server (30) or a file server (440) to the printer. After Tabata's medium form information is sent to a printer, an address is <u>not</u> detected within that media form information and the medium form information is <u>not</u> merged with anything, let alone a document retrieved from a detected address.

For at least these reasons Claim 1 is patentable over Tabata and Russell, individually and combined as are Claims 2-18 which depend from Claim 1.

Claim 19 is directed to a program product comprising a computer readable medium having machine readable program code for implementing the method of Claim 1. For at least the same reasons Claim 1 is patentable, so is Claim 19.

Claim Rejections – 35 USC §103: Claims 11, 12, and 15-17 have been rejected as being unpatentable over USPN 6,537,324 issued to Tabata in view of USPN 6,375,078 issued to Russell in further view of USPN 5,848,413 issued to Wolff. Claims 11, 12, and 15-17 each ultimately depends from Claim 1 and includes all the limitations of that base claim. For at least the same reasons Claim 1 is patentable, so are Claims 11, 12, and 15-17

Conclusion: In view of the foregoing remarks, the Applicant respectfully submits that the pending claims are in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited. The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,
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